

REMARKS/ARGUMENTS

I. INTRODUCTION

Applicant would like to thank Examiner Luong for the telephonic interview (“Interview”) conducted on May 17, 2010. In the Interview, Examiner Luong and the Undersigned reached agreement regarding the amendment to the Specification as set forth herein to traverse the Examiner’s objection to the Specification. The Examiner and the Undersigned, however, did not discuss the merits of the Examiner’s anticipation rejection under 35 U.S.C. § 102 based on JP-H04-78769 to Shigeru (“Shigeru”). Applicant will address in detail herein the objection to the Specification and the basis of rejection advanced by the Examiner.

Claims 14-19, 24, and 27 are pending in the present application. Of these claims, claim 14 is an independent claim and claims 15-19, 24, and 27 are dependent claims. This Amendment is being filed to respond to the Office Action dated May 13, 2000. In the Office Action, the Examiner has referred to claim 25/14 in his rejections. However, in the section titled “IN THE CLAIMS,” it is noted that claim 25 has been withdrawn. Accordingly, Applicant will not respond to the Examiner’s rejection as it applies to claim 25/14.

In the Office Action, the Examiner set forth the following objection to the Specification and rejection related to the claims:

A. The Specification was objected to for failing to provide a proper antecedent basis for the claimed subject matter, such as, “an upper one-half ($\frac{1}{2}$)” in claim 14; and

B. Claims 14-19, 24, and 27 are rejected under 35 U.S.C. § 102(b) for anticipation based on based on JP-H04-78769 to Shigeru (“Shigeru”).

Applicant will demonstrate that the Specification and claims as presented herein overcome the objection and the basis of rejection advanced by the Examiner, thereby, placing in the present application in condition for allowance.

II. LEGAL STANDARD

As stated in Section I, the Examiner has rejected claim claims 14-19, 24, and 27 for anticipation under 35 U.S.C. § 102(b) for anticipation based on Shigeru. The standard for sustaining a rejection for anticipation is a single prior art reference must disclose each and every limitation of the claim. See, e.g., *Schering Corp. v. Geneva Pharma., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“[a] patent [claim] is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention”); *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (“[t]o anticipate, every limitation of the claimed invention must be found in a single prior art reference, arranged as in a claim”); *Kloster Speedsteel AB v. Crucible, Inc.*, 794 F.2d 1565, 1571 (Fed. Cir. 1986) (“absent from the reference of any claimed element negates anticipation”). Shigeru does not meet this standard.

III. THE OBJECTION TO THE SPECIFICATION IS TRAVERSED

In the Office Action at page 2, the Examiner objected to the specification for failing to provide a proper antecedent basis for the term “an upper one-half (½).” In this Amendment, Applicant has amended paragraphs [0019] and [0025] to provide written support for what is shown in Figures 1 and 2 as filed. In the Interview with Examiner Luong on May 17, 2010, the Examiner acknowledged that Figures 1 and 2 showed the disposition of the present invention at the 10 o’clock and 2 o’clock positions, and that these positions were disposed on the upper one-half (½) of the steering control 105 and 211, respectively. Accordingly, the amendments to paragraphs [0019] and [0025] were supported by Figures 1 and 2 in the application as filed and such amendments do not add new matter.

The amendments to paragraphs [0019] and [0025] traverse the Examiner’s objection to Specification. Noting this, it is requested that the examiner withdraw this objection.

IV. CLAIMS 14-19, 24, AND 27 ARE NOT ANTICIPATED BY SHIGERU

The Examiner rejected claims 14-19, 24, and 27 under 35 U.S.C. § 102(b) for anticipation based on Shigeru. The Examiner provided a translation of Shigeru with the Office Action. The Examiner has relied on the four pages of the translation to support the anticipation

rejection raised against claims 14-19, 24, and 27. Applicant submits that Shigeru (1) teaches away from the present invention and (2) does not anticipate the present invention as the Examiner contends.

A review of the Shigeru translation teaches a support 1 that extends outward from the outer peripheral edge of a steering wheel and parallel to a plane across the face of steering wheel. Support 1 is a shaped and positioned for safety reasons to have no portion extent outward from a plane across the face of the steering wheel toward the driver; however, since support 1 is wider than the steering wheel, a portion of its width is behind the plane across the back of the steering.

The support 1 is constructed of the molded plastic that is covered with a layer of cushion material. The surface of the cushion material is then covered with cloth or leather. The driver's hands rest on the top of each support 1 at the outside perimeter of the steering wheel.

Each support 1 is fixedly attached to metal grooves cut at the outside periphery of the steering wheel. A latching mechanism extends through each support 1 so that when the support is positioned in the desired location along a metal groove, the latching mechanism is tightened to lock or fix the support in place. Once the support is fixed in place, it does not move until the latching mechanism is actuated to unlock it. In a second embodiment, instead of a groove being used, each support is fixed in place with a lever or nut using a band or U-shaped metal fitting, respectively. In each case, the support is fixed in place and in order to move it, the support must be unlatched, moved, and then latched such that is fixed to the steering wheel at the new location.

The underlying molded plastic structure of support 1 is made from a light-weight plastic. This light-weight plastic is a rigid material. In order to protect a driver from contacting this rigid structure in an accident, the support is specifically placed such that the driver would come in contact with the steering wheel before the support. To the extent that the driver comes in contact with the support in normal use, the driver would contact the cloth or leather covering the cushion material, which reduces slippage. The following from pages 2-4 of the Shigeru translation supports Applicant's understanding of this reference:

II. Scope of the Patent Claims

1. An invention of support 1 wherein support 1 can be moved along a fixing groove of steering wheel 2 and end fixed to a free place by the action of

lever 5 and metal fitting 6 to make the hands stable by fixing support 1 to the outer periphery of steering wheel 2 and reduce fatigue of driver's hands.

2. A support 1 fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, *metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it...*

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a banned 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.* [Emphasis Added.]

Examiner provided an Appendix with the Office Action in which he marked-up Figures 1, 2 and 4 of Shigeru to attempt to show the features of the present invention. Applicant contends that these figures along with the remainder of the figures clearly show Shigeru (1) teaches away from the present invention, and (2) does not teach or suggest the present invention for the same reasons the Board of Patent Appeals and Interferences ("Board") found in its decision dated August 31, 2009 that the present invention was not anticipated by U.S. Patent No. 2,118,540 to Van Arsdel ("Van Arsdel") or U.S. Patent No. 1,575,828 to Laubach (Laubach").¹

Initially, it is noted in Figures 1 and 4 of Shigeru that support 1 extend outward from the outer edge of the periphery of the steering wheel parallel to a plane across the face of the steering wheel and because support 1 is thicker than the steering wheel, a portion of support 1 protrudes

¹ The decision of the Board of Patent Appeals and Interferences dated August 31, 2009 is attached as Attachment 1.

behind a plane across the back of the steering wheel. No portion of support 1 extends in front of a plane across the face the steering wheel for safety reasons. This is supported at pages 3-4 of the Shigeru translation, where it states:

Support 1 does not come into contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of the steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.

As demonstrated in the quotations above from Shigeru, support 1 extends outward in the plane of the steering wheel with a portion behind that plane. Further, as a safety factor, support 1 never extends in front of the plane across the face of the steering wheel toward the driver. Therefore, noting these features of Shigeru, this reference teaches away from the present invention as claimed in independent claim 14 in which the fatigue relieving/preventing apparatus extends outward from the steering wheel toward the driver.

Claims 15-19, 24, and 27 depend from claim 14. Since claims 15-19, 24, and 27 depend from claim 14, each these dependent claims includes all the features of claim 14. Further, Given this, Shigeru teaches away from claims 15-19, 24, and 27 for the same reasons that it teaches away from independent claim 14 from which each of these dependent claims depend.

A review of Shigeru also supports that this reference does not teach or suggest at least the following feature of independent claim 14 of the present application:

the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

As noted previously, Applicant submits that support 1 of Shigeru, although being constructed of a light-weight plastic, is a rigid structure that is fixed to the steering wheel and is not "deformable out interference with vehicular operator's ability to operate the steering wheel" as set forth in claim 14. Applicant further submits, given the rigid structure of support 1 and its

fixing to the steering wheel by either (1) lever 5 with metal fitting 6 disposed in groove 7, or (2) a lever and band 11, or (3) a nut and U-shaped metal fitting 12, it is cumulative with Van Arsdel and Laubach, and, as such, independent claim 14 is patentable over Shigeru.

In overturning the Examiner's anticipation rejection under 35 USC §102 based on Van Arsdel and Laubach, the Board stated the following regarding these two references. First, with regard to Van Arsdel, the Board stated:

Van Arsdel

15. The Examiner finds from Van Arsdel's disclosure (Van Arsdel, p. 1, right column, l. 49 to p. 2, left column, l. 2 and ll. 28-32) that the grip-rest 2 is adjustable. Lines 28-32 explain that loosening or reversing the screw 14 sufficiently permits the grip-rest 2 to shift position. From this disclosure, the Examiner finds the grip-rest 2 could be placed at a position where it does not interfere with the operation of the steering wheel (*see* Ans. 11-12). As such, the Examiner finds that Van Arsdel's grip-rest 2 has the capability of deforming out of interference with the vehicular operator's body when the pressure from the vehicular operator's body is equal to or greater than the pressure needed to deform the second section out of interference. *Id.*
16. The Appellant argues that the portion of Van Arsdel's disclosure that the Examiner is using (Van Arsdel, p. 2, left column, ll. 28-32) to find that an Arsdel's grip-rest 2 is deformable does not in fact support the Examiner's finding. Instead, this portion of Van Arsdel supports a finding that to move the grip-rest 2, the screw 14 must be loosened, the rest repositioned, and screw 14 tightened. The Appellant argues that this operation is not deforming according to claim 20 [sic.] during normal use of the second section (grip-rest) (parenthetical nomenclature to Van Arsdel). The Appellant argues, instead, once positioned, the grip-rest is fixed. App. Br. 11.

(Board Decision, pp. 10-11)

Anticipation with Van Arsdel

We conclude that Appellant has met his burden in showing that Van Arsdel's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *As the Appellant has stated, Van Arsdel's second section (grip rest) needs to be repositioned in order to*

be moved to a position out of interference with a driver's ability to steer the steering wheel (Fact 16) and parts of the second section (the flanges 4 and 5) give the driver something to push against to steer the car around corners and curves (Fact 17). A structure, as the Examiner has found, see Fact 15, that requires disassembly and reassembly, and permits the driver to push against cannot reasonably be considered a structure that is capable of deforming out of interference as has been claimed. Accordingly, Appellant has met his burden in showing that Van Arsdel's structure is not capable of performing the deformation out of interference function claimed. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27. [Emphasis Added.]

(Board Decision, p. 18)

Now, with respect to Laubach, the Board stated:

21. The Examiner finds that portion 10 is capable of deforming out of interference because the driver can unscrew Laubach's knobs and move them to another position as desired by the driver. Ans. 14.
22. The Appellant argues that:

The description of the knobs and a review of the Figures... [make] plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as does the second section of claim 14. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Therefore, Laubach does not support a prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs. [Emphasis in original.]

App. Br. 15.

(Board Decision, pp. 13-14)

Anticipation with Laubach

We conclude that Appellant has met his burden in showing that Laubach's second section does not inherently possess the characteristic of being capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As Appellant argues, in the manner in which the Examiner has utilized Laubach in order to reach the deforming out of interference function, the knobs need to be disassembled and reassembled in order to be repositioned. See Facts 21 and 22. We agree with Appellant that the disassembly and reassembly of the knobs demonstrates that the knobs are fixed and the only manner of movement to the knobs, short of disassembly, would be destructive in nature to Laubach's device. As such, to find that the functional limitation of the second section deforming out of interference, as set forth in claim 14, is inherently satisfied on a manner of movement that either requires disassembly and reassembly or is destructive is unreasonable. Accordingly, the Appellant has met his burden in showing that Laubach does not possess the capability of deforming as set forth in the claims. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14, 18, and 19/18. [Emphasis Added.] (Board Decision, p. 20)

In the citations to the Board Decision above, it is plain that a structure in which a rigid support is fixed to the steering wheel and can only be repositioned by detaching the rigid structure and reattaching it at a different location does not anticipate claim 14 of the present invention. Applicant submits that Shigeru is like Van Arsdell and Laubach in this regard and, therefore, does not anticipate claim 14.

For convenience, Applicant again provides the following portion of the Shigeru translation (Shigeru, pp. 2-4):

II. Scope of the Patent Claims

1. An invention of support 1 wherein support 1 can be moved along a fixing groove of steering wheel 2 and fixed to a free place by the action of lever 5 and metal fitting 6 to make the hands of stable by fixing support 1 to the outer periphery of steering wheel 2 and reduce fatigue of driver's hands.

2. A support 1 fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, *metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it. When the driver thinks that the change is unnecessary, he/she draws the lever 5 to the upper part of steering wheel 2 having a metal fitting inlet/outlet 4 to make it possible to freely remove the metal fitting.*

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a banned 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.*
[Emphasis Added.]

Applicant's contention molded part 8 of light-weight plastic as shown in Figure 3 of Shigeru is a rigid structure is supported by the translation. Figure 3 shows molded part 8 covered with cushion material 9 and cloth or leather covering 10. Molded part 8 also includes groove 7 into which lever 5 is set. Lever 5 and metal fitting 6 are connected by a connecting rod (Figure 6).

When the driver fixes molded part 8 to the steering wheel, the connecting rod between lever 5 and metal fitting 6 is disposed through the hole in molded part 8 that extends from groove 7 to the inside surface of molded part 8. In order to fix molded part 8 to the steering wheel, there must be considerable fixing tension applied using lever 5 and metal fittings 6. If molded part 8 was not made of a rigid material, support 1 (1) would collapse under this fixing tension and (2) would not be fixed in place and not moveable from that place until the fixing tension was removed as specified in the translation. Further, the translation is explicit that in order to move support 1 from one place to another, it must be unfixed, moved, and refixed to the

steering wheel by operation of lever 5, metal fitting 6, and groove 7. As such, support 1 is a rigid structure covered with cushion material and cloth or leather.

The rigid support structure and method of moving it as disclosed in Shigeru is exactly what the Board has held is not “deforming out of interference with the vehicular operator’s ability to operate the steering wheel when pressure from the portion of the vehicular operator’s body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator’s ability to operate the steering wheel” according to claim 14 of the present invention in its holding that neither Van Arsdell nor Laubach anticipated this claim. Accordingly, it is improper for the Examiner to disregard the Board’s explicit prior holding on this issue.

Noting the foregoing, Applicant has provided at least two grounds that clearly show that Shigeru does not anticipate independent claim 14 of the present application. The first is Shigeru teaches away from the invention of claim 14, and the second is Shigeru does not anticipate claim 14 for the same reasons that the Board found Van Arsdell and Laubach do not anticipate this claim.

Claims 15-19, 24, and 27 depend from claim 14. Since claims 15-19, 24, and 27 depend from claim 14, each of these dependent claims include all the features of claim 14. Given this, Shigeru fails to anticipate claims 15-19, 24, and 27 for the same reasons that it fails to anticipate independent claim 14 from which each of these dependent claims depend.

Applicant’s positions above make plain that he has traversed the Examiner’s anticipation rejection raised against claims 14-19, 24, 27 based on Shigeru and Applicant requests that this rejection be withdrawn.

V. CONCLUSION

Claims 14-19, 24, and 27 are pending in the present application. In the May 13, 2010 Office Action, the Examiner objected to the Specification and rejected claims 14-19, 24, and 27 under 35 U.S.C. § 102(b) for anticipation based on Shigeru. Herein, Applicant has traversed the objection and rejection advanced by the Examiner. Accordingly, Applicant requests that the

objection to the Specification and anticipation rejection be withdrawn. Noting this, the present application is condition for allowance.

The present invention is new, not obvious, and useful. Reconsideration and allow of the claims are respectfully requested and the application be passed issue in due course.

Applicant has also filed a Notice of Appeal and the appropriate filing fee.

Applicant believes no other fee is due for this Amendment. However, if a fee is due, please charge our Deposit Account No. 08-0219, under Order No.: 0114089.121US1 from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: May 20, 2010

/Wayne M. Kennard

Wayne M. Kennard

Registration No.: 30,271

Attorney for Applicant(s)

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
617-526-6000 (telephone)
617-526-5000 (facsimile)